

REMARKS

The Office Action mailed February 5, 2009, has been received and reviewed. Claims 1 and 3-14 are currently pending in the application. Claims 12 and 13 are allowed. Claim 11 is objected to as depending from a rejected base claim. Claims 1, 3-10 and 14 stand rejected. Applicant has amended no claims, and respectfully requests reconsideration of the application as presented herein.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,713,074 and U.S. Patent No. 6,111,857

Claims 1, 3-6, 8, 9 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,713,074 to Hulbert ("Hulbert") in view of U.S. Patent No. 6,111,857 to Soliman *et al.* ("Soliman"). Applicant respectfully traverses these rejections as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicants' disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1, 3-6, 8, 9 and 14 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the

claims limitations.

Regarding independent claim 1 with claims 3-6, 8 and 9 depending therefrom, and independent claim 14, Applicant's independent claims 1 and 14 include claim limitations not taught or suggested in the cited references. Generally, Applicant's invention as claimed recites, *inter alia*, **repeating** a step **until a sum** determined at the mobile station **of energy reaches a certain level**. Specifically regarding a sum determined at the mobile station of energy, Applicant's invention as presently claimed in independent claims 1 and 14 each recite, *inter alia*, **"repeating [retransmitting] until a sum** determined at the mobile station **of the first and further symbol energy amounts ... is great enough"** Applicant respectfully asserts that neither Hulbert nor Soliman, either individually or in any proper combination, teach or suggest Applicant's invention as presently claimed in independent claims 1 and 14 of **"repeating [retransmitting] until a sum** determined at the mobile station **of the first and further symbol energy amounts ... is great enough"**

The Office Action concedes:

For claim 1 [and] 14, ... Hulbert does not expressly disclose:

(C) repeating step (B) until **a sum** determined at the mobile station **of the [first and further] symbol energy amounts used to transmit the traffic information** [] is great enough to permit correct demodulation by the mobile station.. (Office Action, pp. 3 and 6; emphasis added).

The Office Action then alleges:

Soliman *et al.* disclose ... **a sum determined** at the mobile station (**the total forward link power received at each location (mobile station) is calculated means**) (col. 17, lines 47-49) **of the first and further symbol energy amount used to transmit the traffic information** is great enough to permit correct demodulation by the mobile station (col. 17, lines 49-56). (Office Action, pp. 3-4; emphasis added).

Applicant respectfully disagrees. Generally, Applicant claims a "sum ... of the first and further symbol energy amounts used to transmit the traffic information." Accordingly, **Applicant's claimed sum includes addends of "first symbol ... energy amounts used to transmit the traffic information" and "further symbol energy amounts used to [RE]transmit the traffic information."** Accordingly, Applicant's claimed "sum" is of symbol energy amounts for the same traffic information. In contrast, Soliman's "sum" (*i.e.*, Soliman's "total forward link

power”) is not a sum of energy of *a transmission and retransmissions of the same traffic information*, but is a sum or total of the transmission powers of concurrent forward link channels. Specifically, Soliman teaches:

The *allocation of the traffic channel alters* the amount of power associated with the particular forward link signal, which in turn can alter *the total forward link power* received at each location. (Soliman, col. 17, lns. 60-63; emphasis added).

Once the forward link ERP for each base station is set, the forward link power received at each location is determined. The *forward link power received at each location is the sum of the forward link power received at the location from each base station*.... (Soliman, col. 19, lns. 48-52; emphasis added).

[C]*calculating the forward link effective radiated power* for each base station ... *include[s] the number of forward link traffic channels* established by each base station, the forward link ERP for each base station, and the forward link power received at each location. (Soliman, col. 22, lns. 21-32; emphasis added).

Clearly, Soliman’s “*total forward link power*” is a sum or total of *concurrent* energies all *concurrent* forward link channels at a particular instance or period and not Applicant’s claimed “sum” of “first symbol ... energy amounts used to transmit the traffic information” and “further symbol energy amounts used to [RE]transmit the traffic information.” Stated another way, Soliman’s “sum” is a concurrent total power and not a “sum” of symbol energy of a transmission of traffic information added to symbol energies of subsequent retransmission(s) of the traffic information. Furthermore, Applicant claims “*repeating [retransmitting] until a sum determined at the mobile station of* the first and further symbol energy amounts ... is great enough” which cannot be taught by Soliman’s concurrent totaling of power of concurrent forward link channels.

Therefore, since neither Hulbert nor Soliman teach or suggest Applicant’s claimed invention including “*repeating [retransmitting] until a sum determined at the mobile station of the first and further symbol energy amounts ... is great enough*”, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in independent claims 1 and 14. Accordingly, Applicant respectfully requests the rejections of independent claims 1 and 14 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 3-6, 8 and 9 which depend therefrom because a dependent claim is obvious only if the independent claim

from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 3-6, 8 and 9 which depend therefrom.

Obviousness Rejection Based on U.S. Patent No. 5,713,074, U.S. Patent No. 6,111,857 and U.S. Patent No. 6,581,176

Claims 7 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hulbert in view of Soliman and further in view of U.S. Patent No. 6,581,176 to Seo ("Seo"). Applicant respectfully traverses these rejections as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claims 7 and 10 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to independent claim 1 and claims 7 and 10 which depend therefrom.

Allowed Claims 12 and 13/Objection to Claim 11

Claims 12 and 13 are allowed.

Claim 11 stands objected to as being dependent upon a rejected base claim, but is indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claim in its present form, along with all other claims presently under consideration, is in condition for allowance.

Finality of Next Office Action Precluded

Applicant has traversed the rejection of claims 1, 3-6, 8, 9 and 14 by argument and not amendment. Therefore, the finality of the next office action would be improper as Applicant is entitled to an examination on the merits and to amend as a matter of right. In the present Office Action, Applicant's independent claims 1 and 14 were not completely examined as to all of the elements. Accordingly, Applicant submits that this omission to examine all elements of

Applicant's claimed invention amounts to a failure to articulate a *prima facie* case of unpatentability and the burden to rebut this "rejection" has not yet shifted to the Applicant. Consequently, a next office action cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, presuming that such an office action sets forth a *prima facie* case. (MPEP § 706.07(a)).

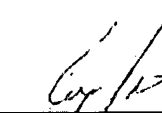
CONCLUSION

Claims 1 and 3-14 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned representative.

Respectfully submitted,

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By:



Rupit Patel, Reg. No. 53,441
(858) 651-7435

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 658-5787
Facsimile: (858) 658-2502